

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAKI TAKEGAMI, KIMIAKI NAKAMURA,
TADASHI SAKURAI, and TEIJI UMENO

Appeal No. 1997-4188
Application No. 08/373,528

HEARD: OCTOBER 24, 2001

Before COHEN, NASE, and BAHR, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3, 5 through 7, 10 through 15, and 17 through 20 (Paper No. 24). According to the final rejection (Paper No. 19), claims 21 through 25, 27, and 28 stand allowed. In a main answer (Paper No. 26), the examiner (1) points out that claim 28 was inadvertently grouped in the final rejection with allowed claims, and introduces a new ground of rejection and (2) notes that appellants have withdrawn the appeal as to claims 17 through 20. In light of the above, we have before us claims 1, 3, 5 through

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7, 10 through 15, and 28 under rejection, with claims 21 through 25, and 27 being allowed.

Appellants' invention pertains to a fuel tank, fuel pump arrangement for supplying fuel to an internal combustion engine. A basic understanding of the invention can be derived from a reading of exemplary claims 1 and 15, copies of which appear in the APPENDIX to the substitute brief (Paper No. 30).

As evidence of obviousness, the examiner has applied the documents listed below:¹

Fedeleme et al (Fedeleme)	4,790,185	Dec. 13, 1988
Weaver	4,651,701	Mar. 24, 1987
Yamamoto (Japan)	61-104289	Jul. 2, 1986
Sato (Japan)	63-029676	Jan. 20, 1982

The following rejection is before us for review.

¹ Our understanding of the two listed Japanese documents is derived from a reading of translations thereof prepared for the United States Patent and Trademark Office. Copies of the respective translations are appended to this opinion.

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Claims 1, 3, 5 through 7, 10 through 15, and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Japan '289 in view of Japan '676, Weaver, and Fedelem.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the main and supplemental answers (Paper Nos. 26 and 31), while the complete statement of appellants' argument can be found in the substitute brief (Paper No. 30).

OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully assessed appellants' specification and claims, the applied teachings,² and the respective viewpoints of appellants and the examiner. As a

² In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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consequence of our review, we make the determination which follows.

We procedurally reverse the examiner's rejection of appellants' claims for the reasons which follow.

In carefully considering the subject matter defined by independent claims 1 and 15, we have determined that the claim language addressing the positioning of the "opening" is not fairly understood on the basis of the recitation of the opening being disposed above the area wetted by fuel when the fuel tank is "at least less than one half full" so that a "substantial amount" of fuel will remain in the fuel tank if said opening is not closed. More specifically, the "at least less than one half full" claim language appears to be inconsistent with the recitation in the underlying specification (page 8) which recitation makes it clear that the opening is entirely above the area of the fuel tank wetted when the fuel tank is at least half filled (Fig. 2); this latter recitation would appear to provide an understanding of the claimed feature of retaining a "substantial amount" (term of degree) of fuel in the fuel tank if the opening is not closed. A new rejection under the provisions

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of 37 CFR § 1.196(b) is introduced, infra, based in part upon the above noted indefiniteness of the claimed subject matter. It follows that, with the claims being indefinite as indicated, it would entail considerable and inappropriate speculation on our part to try to comprehend the metes and bounds of the claimed subject matter. Since a rejection under 35 U.S.C. § 103 cannot be based on speculation and assumptions, In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962), we are constrained to procedurally reverse the examiner's rejection under 35 U.S.C. § 103. We take no position as to the applicability of the applied prior art to the claims on appeal since this prior art cannot be fairly assessed until it can be determined what in fact is being claimed.³

Under the provisions of 37 CFR § 1.196(b), we make the following new rejection.

³ We would only add the following commentary. Figure 5 of Japan '289 clearly reveals a pump support base 7 for a fuel pump 8 closing off a vertically extending opening in fuel tank 3. As to the Japan '676, Weaver, and Fedelem references, collectively they appear to corroborate what was known in the art when the present invention was made, as set forth in the "BACKGROUND OF THE INVENTION" section of appellants' specification (pages 1 through 3).

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Claims 1, 3, 5 through 7, 10 through 15, and 28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. We incorporate herein our above analysis of claims 1 and 15 relative to the indefiniteness therein. The following additional matters also raise issues of indefiniteness. The preamble "fuel tank" in each of dependent claims 3, 5, 6, 7, 10 through 14, and 28 is not consistent with the preamble "fuel tank, fuel pump arrangement" of parent claims 1 and 15. The preamble of claims 5, 28, and 12 seems to clearly indicate that these claims are drawn to a fuel tank (fuel pump arrangement) per se; however, the express inclusion of the "engine" in these claims is inconsistent with the above understanding of the scope of the claims since it appears that they may be drawn to the combination of a fuel tank, fuel pump arrangement and an internal combustion engine. The scope of claims 11 and 12 is indeterminate in light of the recitation of the "motorcycle". Additionally, as to claim 15, line 3, the reference to "said upper wall portion" is ambiguous in meaning since antecedent basis for an upper wall portion is not present in claim 15.

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This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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In summary, this panel of the board has procedurally reversed the rejection of appellants' claims and introduced a new ground of rejection.

The decision of the examiner is reversed.

REVERSED; 37 CFR 1.196(b)

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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